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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,743	02/23/2004	Dany Sylvain	7000-272	2454
27820 7590 11/03/2009 WITHROW & TERRANOVA, P.L.L.C. 100 REGENCY FOREST DRIVE SUITE 160 CARY, NC 27518				
EXAMINER				
KIM, WESLEY LEO				
ART UNIT		PAPER NUMBER		
2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,743

Applicant(s)

SYLVAIN, DANY

Examiner

WESLEY L. KIM

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 30-44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 and 30-44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date 10/2/09
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 7/16/09 have been fully considered but they are not persuasive.

- Applicant argues Stewart does not teach transitioning a call with a mobile terminal from a cellular connection to a local wireless connection and further states that Stewart does not disclose a local wireless connection.

The examiner respectfully disagrees. Stewart teaches transitioning from a cellular connection (Col.11:lines 9-14, MSC based wireless system) to a local wireless connection (Col.11:lines 9-14, Generic C-based system). The Claimed limitation is broadly recited and does not limit what a local wireless connection can be. The examiner has interpreted the Generic C-based system to be the local wireless communication system.

- Applicant argues that Stewart does not teach "effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal" and does not teach "providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection".

The examiner respectfully disagrees. The Stewart reference teaches "effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications

with the mobile terminal" (Col.13:lines 19-39 and Col.11:lines 53-57, the base station element 306 is terminal adaptor and handover is from MSC317 to switch 316).

Stewart further teaches "providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection" (Col.13:lines 19-39, handover message is inter-switch handoff message)

- Applicant argues that the examiners interpretation of terminal adaptor is incorrect since the first base station element 306 mapped to the terminal adaptor does not support WLAN or 802.11 protocols.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., local wireless area uses WLAN or 802.11 protocols) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Local wireless connection is a very broad and the examiner has interpreted the Generic C-based system to be the local wireless communication system.

- Applicant argues that Stewart does not teach the inter-switch handoff connection is established to the mobile terminal via the terminal adaptor and then the handoff is effected by connecting the already established connection between

the wireless switch and the entity (referred to as the "second connection" in claim 1) with the inter-switch handoff connection to the mobile terminal via the terminal adaptor.

The examiner respectfully disagrees. Stewart teaches "effect establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor (Col.13:lines 19-24, via the terminal adaptor, handover is completed), which supports local wireless communications with the mobile terminal (Col.13:lines 19-25 and Fig.8:623, terminal adaptor is the base station element 306 and handover is complete so a new connection is established).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-8, 11-15, 30-32, 35-37, and 40-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Steward et al (US 6373828 B1).

Regarding Claims 1 and 30, Steward teaches transitioning a call with a mobile terminal from a cellular connection to a local wireless connection (Col.11:lines 9-14), the system comprising: a) at least one communication interface (Fig.4: signaling interface 350); b) a control system (Fig.4:312 and Col.12:lines 35-38, the computing platform 312 is the control system) associated with the at least

one communication interface (Fig.4:350, connected to the control system so it is associated with the interface) and adapted to:

i) receive an inter-switch handoff request from a wireless switch supporting a call to the mobile terminal over a cellular access network (Col.12:lines 35-38), the call comprising a first connection from the wireless switch (Fig.4:MSC 317) to the mobile terminal and a second connection between the wireless switch and an entity (Col.11:lines 9-14 and Col.5:lines 60-66, mobile moves from the cellular network to the local wireless connection so there is a pre-established first connection from the mobile station to the MSC 317 and since the mobile has a call in progress there is a second connection to the other phone (i.e. entity)); ii) effect establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal (Col.13:lines 19-25 and Fig.8:623, terminal adaptor is the base station element 306 and handover is complete so a new connection is established); and iii) provide an inter-switch handoff instruction to the wireless switch (i.e. MSC 317) to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection (Col.13:lines 25-39 and Fig.8:627 and 629, computing platform forwards a mobile station (i.e. inter-switch handoff instruction) to the msc).

Regarding Claims 2 and 31, Steward further teaches the inter-switch handoff connection is established in part between a wireline switch and the terminal adaptor (Col.13:lines 1-6, wireline switch 316 and terminal adaptor 306).

Regarding Claims 3 and 32, Steward further teaches the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol (Col.12:lines 35-38, IS-41 is an AMPS cellular protocol) while the establishment of the inter-switch handoff connection is effected using a public switched telephone network-based protocol (Col.9:lines 53-55 and Col.4:lines 26-43, a mobile station in the generic network communicates using a PSTN based protocol).

Regarding Claims 6 and 35, Steward further teaches inter-switch handoff connection is established using a directory number associated with the mobile terminal when supported via the terminal adaptor (Col.12:lines 46-55, TDN is a Directory Number)

Regarding Claims 7 and 36, Steward further teaches the inter-switch connection is established in part over a packet network (Col.4:lines 51, use of internet protocols indicates a packet network) operatively coupled to the terminal adaptor (Fig.4:306) (Col.4:lines 51, Internet Protocol).

Regarding Claims 8 and 37, Steward further teaches the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol (Col.12:lines 35-38, IS-41 is an AMPS cellular protocol) while the establishment of the inter-switch handoff connection is effected using a packet-based communication session protocol (Col.4:lines 51, signal 355 in Fig.4 can be an IP connection so the establishment of a connection would be IP based).

Regarding Claims 11 and 40, Steward teaches providing a inter-switch handoff message to the wireless switch to confirm handoff to the inter-switch handoff connection (Col.13:lines 25-39 and Fig.8:627 and 629, computing platform forwards a mobile station (i.e. release message), to the MSC 317 to confirm handoff of the call from the cellular connection to the local wireless connection).

Regarding Claims 12 and 41, Steward teaches the inter-switch handoff request comprises a cell site identifier to which the wireless switch is attempting to handoff the call, the cell site identifier corresponding to the terminal adaptor (Col.12:lines 24-26).

Regarding Claims 13-14 and 42-43, Steward teaches the cell site identifier is provided to and then accessed by the wireless switch by/from the mobile terminal (Col.12:lines 12-26 and 35-44, the target cell identifier is provided by the mobile terminal moving around and the determination by a base station elements that a handover request needs to be sent and accessed by platform 312).

Regarding Claims 15 and 44, Steward teaches providing the cell site identifier to the wireless switch (Col.12:lines 21-26).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-5, 9-10, 33-34, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steward et al (US 6373828 B1) in view of Koistinen (US 7136375 B1).

Regarding Claims 4, 9, 33, and 38, Steward teaches all the limitations as recited in claim 2, and Steward further teaches of the utilization of internet protocols at the wireline switch side, which indicates the presence of a packet network (Col.4:lines 51) and Steward further teaches a call initiation request (i.e. handover request) sent from a cellular network to a generic network (Col.11:lines 9-14), however **Steward does not expressly teach** first and second media gateways, the first media gateway connected to the wireless switch via a cellular-based trunk and the second media gateway connected to the wireline switch via a public switched telephone network-based trunk, the method further comprising sending call initiation messages to the first and second media gateways and the wireline switch to establish the inter-switch handoff connection.

Koistinen teaches first and second media gateways (Fig.3, gateway 304 and gateway 306), the first media gateway connected to the wireless switch via a cellular-based trunk (Fig.3, trunk between 301 and 304) and the second media gateway connected to the wireline switch via a public switched telephone network-based trunk (Fig.3 and Col.4:lines 1-4, trunk between 305 (i.e. PSTN) and 306).

Therefore, it would have been obvious to modify Steward with Koistinen at the time of the invention to provide a network element to connect the various networks to one another to provide interoperability so that the user of a mobile device is able

to access various networks for the purposes of making a phone call and sending email while on the move with a single device as opposed to carrying around multiple devices, i.e. phones and laptops.

Regarding Claims 5, 10, 34, and 39, Koistinen further teaches that gateways, i.e. the first and second, facilitate interworking between the cellular-based trunk and the public switched telephone network-based trunk over a packet network (Col.3:lines 26-31).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WESLEY L. KIM** whose telephone number is

(571)272-7867. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Wesley L Kim/
Examiner, Art Unit 2617